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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/661,348
Filing Date: September 12, 2003
Appellant(s): TEMPEST ET AL.

Stephen C. McKenna
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 7, 2008 appealing from the Office action mailed October 5, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be

identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it contains numerous features which are not recited in the claims. For example, the description of claim 1 recites that the bonus indicator does not award credits when a certain result is obtained, but rather indicates whether or not the player of the primary game is entitled to proceed to a bonus feature. Nowhere in claim 1 is this feature, particularly the failure to award credits, recited. The summary of claim 22 recites that the bonus indicator is not a play for credit game. Again, this is not recited in claim 22. Similar language is included in the summary of claims 49 and 51, but not recited in the claims themselves.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 22-30, 31-41 and 49-51 are rejected under 35 USC 102(e) as being anticipated by Cannon. The rejections are set forth more fully in the Final Rejection dated October 5, 2007.

(10) Response to Argument

Cannon is directed to a gaming machine where a plurality of games may be played simultaneously. See column 8, lines 33-45. Column 8, line 66 to column 9, line 29 of Cannon describes various types of games which may be played simultaneously, including spinning reel slot machines, poker games, blackjack games, keno, roulette, bingo etc. With respect to applicant's arguments that Cannon requires a separate credit for each game, while the claimed invention recites a bonus indicator which is enabled by credit wagered in a primary game, Cannon discloses in column 26, lines 21-63 that a player may be presented with a "complementary game" which is displayed simultaneously with a primary game (the Office Action of October 5, 2007 erroneously refers to column 23 for this disclosure). Lines 34-37 recite that a "complimentary game may be caused to play automatically in response to a player's initiation of play in one or more other games of chance in which wagers have been placed". Here, the "one or more other games" is a primary game, and the complimentary game is a bonus indicator. Lines 46-49 explicitly recite that a wager amount on a primary game may also be applied to the complementary game. The complementary game operates

independently of the primary game. This language reads on the claimed limitation that the bonus indicator is enabled by credit wagered in a primary game. It should also be noted that at least with respect to apparatus claims 49 and 51, the phrase "enabled by credit wagered in said primary game" is functional language which describes the intended purpose of the apparatus, rather than reciting further structural limitations to the claims.

The appellant is correct that the secondary games described in column 8, lines 33-45 and column 8, line 66 to column 9, line 29 complementary game described in column 26, lines 21-63 are considered by the examiner to be a "bonus indicator" and that any winnings from such games are considered by the examiner to be a "bonus feature". The games indicate whether the player is entitled to a bonus. The appellant is essentially arguing that Cannon fails to disclose certain limitations which may be described in the specification, but are not recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While appellant argues that the terms "bonus indicator" and "bonus feature" have specific definitions in the specification, the specification fails to provide such definitions. Rather, certain alternative embodiments have merely been deleted from the specification, in the Amendment dated October 3, 2006. Particularly in light of the recitation in certain dependent claims, including claims 3-6, 24-27 and 35-38 that the bonus indicator is a "roulette type wheel" or "one or more reels" Cannon reads on the claimed features under the broadest reasonable interpretation of the claim language.

The "bonus feature" in particular cannot have any special definition because the specification as originally filed did not even mention a "bonus feature", much less provide a special definition. The amendment to the specification merely recites that a player may "participate in a bonus round or feature". On its face this does not constitute a special definition of "bonus indicator" or "bonus feature", and it cannot be interpreted as such because to do so would result in the introduction of new matter into the disclosure.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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February 3, 2009

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